

REMARKS

Status of the Claims

Claims 1, 3-5, 9-11, and 14-20 are currently pending. Claims 2, 6-8, 12, and 13 have been canceled without prejudice or disclaimer of the subject matter claimed therein. Claims 10, 11, and 15-20 are withdrawn from consideration as being directed to a separate invention. Claims 1, 3-5, 9, and 14 are currently under examination.

Claims 1, 10, and 19 have been amended and claim 20 has been added as a new claim. The amendments to the claims and the addition of claim 20 do not include prohibited new matter. Representative support for the amendments to the claims can be found in the claims as originally filed. Representative support for new claim 20 can be found in claim 19 as originally filed.

Applicants reserve the right to file divisional and/or continuation applications to pursue the subject matter deleted from the claims as originally filed.

Rejoinder

Applicants would like to thank the Examiner for indicating that rejoinder of method claims will be considered when the base compound claims are deemed allowable.

Rejection of the Claims Under 35 U.S.C. § 112, First Paragraph

Claims 1, 3-5, 9, and 14 are rejected under 35 U.S.C. § 112, first paragraph as allegedly only enabling for a limited class of compounds of formula (1).

Applicants respectfully submit that the specification teaches how to make and use the claimed invention as stated in the previous response, dated August 11, 2008. Moreover, at a minimum the specification teaches how to make and use some of the compounds of formula (1), as acknowledged by the Office Actions dated May 9, 2008, and October 8, 2008.

However, without acquiescing to the propriety of the rejection, Applicants have amended claim 1 as suggested by the Office Action to overcome the rejection. Thus, Applicants respectfully request withdrawal of the rejection.

Rejection of the Claims Under 35 U.S.C. § 103(a)

Claims 1, 3-7, 9, and 14 are rejected 35 U.S.C. § 103(a) as allegedly being unpatentable over WO 2001094342 (Lee).

As stated in the previous response, Lee does not teach or suggest the claimed invention because Lee only discloses phenyl oxazolidinone derivatives substituted with pyridine or pyrimidine derivatives at the 4-position of the phenyl ring. The phenyl oxazolidinone derivatives of Lee do not encompass pyridine substituted compounds bearing a carbon-linked heterocyclic substituent. Moreover, there is no reason to make the necessary changes to the compounds of Lee to arrive at the claimed invention with reasonable expectation of success because Lee only teaches that when the R₄ substituent on the pyridinyl ring contains a heterocyclic group, it must either be directly attached via a ring nitrogen or must be linked to the pyridine ring by at least one carbon atom or an oxygen atom. Thus, Lee neither teaches nor suggests the claimed invention.

The Office Action alleges that it would be obvious to arrive at the claimed compounds by optimizing known structural templates. Applicants respectfully submit that the presently claimed compounds do not represent mere optimization of the compounds of Lee. To arrive at the claimed compounds having four rings linked together and containing a pyridyl phenyl biaryl linkage, it is necessary to select R₂ as pyridyl substituted by R₄ in formula (1). Although R₄ in Lee can be a heterocyclic ring, thereby giving a four ring compound, this fourth ring, according to the definition of R₄ in Lee, must either be directly attached via a ring nitrogen atom, as in NR₇R₈, or must be linked to the pyridinyl or pyrimidinyl ring by at least one carbon atom, as in -(CH₂)mR₉, or an oxygen atom, as in -OR₁₀. There is no disclosure in Lee of compounds having A-C'C''-B of the presently claimed compounds where A is C-linked isoxazoline, C' is pyridyl, C'' is phenyl and B is an oxazolidinone ring.

The Office Action also alleges that it would be obvious to arrive at the claimed compounds by simply varying R_{1a} and R_{1b} from among the alternatives taught by Lee. As discussed above, it would not be obvious to obtain the claimed compounds because Lee does not provide any reason to select pyridinyl substituted compounds as a starting point in preference to the pyrimidinyl substituted compounds also disclosed by Lee. Also, Lee provides no reason to introduce a ring carbon linked isoxazole ring at R₄. In order to arrive at a fourth ring in the

structure corresponding to ring A in the presently claimed compounds, a person having ordinary skill in the art must first select the possibility that R₄ forms a ring from among the many options recited for R₄ and then substitute this with a carbon linked isoxazole ring. Lee provides no reason to do this selection and substitution with any reasonable expectation of success.

Applicants respectfully point out that in *In re Baird*, the court held that a disclosure of a generic formula that may encompass a claimed compound does not, without more, render a specific compound obvious. *In re Baird*, 29 USPQ2d 1550 (Fed. Cir. 1994). In *Baird*, the court found that a patent disclosing a generic diphenol formula encompasses various different diphenols in addition to the claimed bisphenol, did not render the claimed bisphenol obvious because the patent does not provide specific variables for picking the specific bisphenol. Similar to the facts in *In re Baird*, Lee does not teach selecting R₂ as pyridyl substituted by R₄ in formula (1) of Lee and introducing a ring carbon linked isoxazole ring at R₄. Thus, Lee does not render the claimed invention obvious.

Double Patenting

A. Claims 1, 3-7, 9, and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application Nos. 11/569,150; 11/569,148; 11/569,408; 11/569,208; 10/506,020; and 10/536,687.

Applicants respectfully request that this rejection be held in abeyance until allowable subject matter has been indicated.

B. Claims 1, 3-7, 9, and 14 are allegedly rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 7,192,974.

Enclosed is a terminal disclaimer disclaiming the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§154 and 173, as presently shortened by any terminal disclaimer, of prior U.S. Patent 7,192,974.

Conclusion

The foregoing amendments and remarks are being made to place the application in condition for allowance. Applicants respectfully request entry of the amendments, reconsideration, and the timely allowance of the pending claims. A favorable action is awaited. Should an interview be helpful to further prosecution of this application, the Examiner is invited to telephone the undersigned.

If there are any additional fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Dated: **January 6, 2009**
Morgan, Lewis & Bockius LLP
Customer No. **09629**
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
202-739-3000

Respectfully submitted,
Morgan, Lewis & Bockius LLP

/Sally Teng/
Sally P. Teng
Registration No. 45,397